

- The response does not raise new issues that would require further consideration and/or search.
- The response does not raise the issue of new matter.
- The response does not present any additional claims.
- The response addresses issues that are necessary and could not have been presented prior to final rejection.
- Under 37 C.F.R. §1.113(b), the Examiner in making a final rejection shall state all the grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof. Applicants note that the Examiner's position from the prosecution record is not clearly supported from a legal or substantive viewpoint.
- Applicants could not have raised these necessary arguments prior to final rejection as these new grounds of rejection were presented in the Final Office Action.

Claims Rejection Under 35 U.S.C. §103

Claims 1-3, 5-6, 9, 11, 12, 14, 15, and 17-22 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,546,620, issued to Matthews, in view of U.S. Patent No. 5,930,854, issued to O'Neill et al. Claims 7, 8, and 16 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Matthews, in view of O'Neill et al., and further in view of U.S. Patent No. 4,272,713, issued to Williams et al. Claim 10 has been rejected under 35 § U.S.C. 103(a) as allegedly being unpatentable over Matthews, in view of O'Neill et al., and further in view of U.S. Patent No. 3,911,512, issued to Plate. Such rejections are traversed as follows.

Independent claim 1 is directed to a play kit comprising a pillow that in turn comprises a pillow body and at least two attachment mechanisms. The pillow body is constructed of a filer material and includes a medial region and pair of opposing arms that form a generally open well. Importantly, this open well is open to a surface onto

which the pillow is adapted to rest to permit a user to lie directly on the surface when lying within the well. Further, at least one bar is positionable over the pillow, wherein the attachment mechanisms are configured to be attached to the bar. The bar includes at least one coupling mechanism to permit a toy to be coupled to the bar and held above the pillow.

Applicants note that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Matthews or O'Neill et al. references or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references, alone or in combination, teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). Applicants respectfully submit that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

Firstly, Applicants note that no motivation or suggestion, either in the cited art references or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to combine the reference teachings so as to produce the claimed invention. In combining the Matthews disclosure with that of O'Neill et al., the Examiners states that although, "Matthews fails to disclose a bar that is positioned over the pillow .... It would have been obvious to one of ordinary skill in the art at the time of the invention to position bars over the pillow body .... in order to stimulate the infant". Office Action dated June 22, 2002, page 2, paragraph 2. Applicants respectfully disagree.

A close examination of the Matthews reference reveals that one or more straps (50, 50', 50'') for directly attaching a toy (52, 54, 56) to a resilient support cushion (12) are attached to the support in a location wherein the toys will only be accessible by a baby when in a prone position (e.g. a back portion of the resilient cushion supports the baby's chest). See col. 1, lines 50-64. As such, the baby cannot reach either the straps or toys secured in the straps when the baby is positioned in the cushion in a supine position (e.g. a back portion of the resilient cushion supports the baby's head and/or neck). See col. 4, lines 25-34. Matthews further notes in col. 1, lines 64-67, that the straps are positioned only on a back section of the support cushion so as not to interfere with the support function of the device. The O'Neill et al. patent, in contrast, describes a toy bar framework (6) where the baby has to clearly lie or sit face-up (e.g. in a supine orientation) to play with toys (34) coupled to the bar framework as the framework and toys are positioned over an annular inflatable support device (4). See col. 4, lines 46-67. As such, the Matthews reference teaches away from Applicants invention because a person of ordinary skill in the art, upon reading the Matthews patent, would not have been motivated to add the toy bar framework (6) of O'Neill et al. over the support cushion of Matthews.

Applicants request, if the present rejection is maintained, that the Examiner show or explain where the cited art references, or how knowledge of those skilled in the art, provide a suggestion or motivation to combine the reference teachings so as to produce the claimed invention of claim 1 of at least one toy bar over the pillow, wherein a toy coupled to the bar is held above the pillow. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings) (copy enclosed). Absent any evidence of a cited suggestion or reasonable motivation in the cited art references to combine the reference teachings so as produce the claimed invention of a play kit having at least one bar that is positionable over the pillow and permits a toy to be held above the

pillow, *prima facie* obviousness of claim 1 (and dependent claims 2, 3, and 5-8) has not been established.

Secondly, even assuming that the Matthews and O'Neill et al. disclosures may be combined (which combination is disputed), the cited art references still fail to teach or suggest all of the limitations of claim 1. For example, the attachment mechanisms (26) of claim 1 are configured to attach the bar (30, 32) to the pillow (12). The bar in turn includes a coupling mechanism (40) to permit a toy (42) to be coupled to the bar. The straps of Matthews instead are configured to directly attach a toy to a resilient support cushion, not to a toy bar. See col. 4, lines 11-24. In addition, both the Matthews and O'Neill fail to teach or suggest an open well that is open to a surface upon which the pillow is adapted to rest such that the user may lie directly on the surface when lying within the well as claimed in claim 1. O'Neill, in contrast, describes an annular support device (4) incorporating a padded base part (14) upon which the infant may lie, kneel, or sit when in an accommodating region (7). See col. 3, lines 63-65. Matthews describes a support (12) having a mat (40) which occupies an interior cavity (30) of the support such that the baby does not contact the floor when within the support. See col. 2, lines 1-8. In fact, the cited art references teach away from the present invention in that the respective devices (i.e. padded base part or mat) prevent direct contact with the surface. As such, *prima facie* obviousness has not been established, and it is therefore respectfully requested that the § 103(a) rejection of independent claim 1 (and dependent claims 2, 3, and 5-8) be withdrawn and the claims be allowed.

Independent claim 9 recites a play kit comprising a pillow cover that is adapted to be placed around a pillow and at least one bar that is positioned over the pillow cover via an attachment mechanism. The pillow cover forms an open well that is open to a surface onto which the pillow cover is adapted to rest such that a user may lie directly on the surface when lying within the well. The bar includes at least one coupling mechanism to permit a toy to be coupled to the bar and held above the pillow cover. Hence, as claim 9 includes similar limitations as those found in claim 1, it is respectfully

requested that the § 103(a) rejection of independent claim 9 (and dependent claims 10-12 and 14-17) be withdrawn and the claims be allowed.

Independent claim 18 is similarly directed at a play kit comprising a pillow forming an open well that is open to a surface onto which the pillow is adapted to rest such that a user may lie directly on the surface when lying within the well and a suspension system that is configured to suspend at least one toy over the pillow. As such, *prima facie* obviousness of claim 18 (and dependent claims 19-21) has not been shown for many of the reasons given above with respect to claim 1 and accordingly the claims should be allowed.

Independent claim 22 recites a method for presenting a toy including, in part, the steps of placing a pillow onto a surface, with the pillow defining a generally open well that is open to the surface, attaching at least one bar to the pillow, and coupling a toy to the bar such that the toy is suspended over the pillow. Therefore, it is respectfully requested that the § 103(a) rejection of independent claim 22 be withdrawn and this claim be allowed for many of the reasons given above with respect to claim 1.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 650-326-2400.

Respectfully submitted,



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